

REMARKS

I. Preliminary Matters

Applicant acknowledges with appreciation the Examiner's indication of allowable subject matter in claims 1 and 17-47. In response to subject Office Action, Applicant has amended claims 34, 35, and 47 to recite single dependancies. Claims 48-71 have been added to separately recite the prior multiple dependancies.

II. Objections Under 37 C.F.R. § 1.75

The Examiner objected to claims 34, 35, and 47 under Section 1.75 of the Statute as being of improper form because a multiple dependent claim cannot refer to a plurality of different sets of claims of different features. In making this objection, the Examiner relies on MPEP Section 608.01(n).

As indicated above, Applicant has amended claims 34, 35, and 47 to recite single dependancies only. In view thereof, Applicant believes that amended claims 34, 35, and 47, and added claims 48-71, are in compliance with all the requirements regarding dependancies. Thus, Applicant believes that the Examiner's objection for improper form under Section 1.75 has been obviated by the indicated amendments.

The Examiner has also objected to claim 46 as being an improper dependent claim because it recites an optical disk system but depends from method claim 36. A similar rejection appears to have been also applied to claims 34, 35, and 46. Applicant respectfully disagrees with the Examiner's objection in this regard.

Applicant has closely reviewed the entirety of MPEP Section 608.01(n) and finds no basis for objection to claim 46 or amended claims 34, 35, and 46, consonant with the Examiner's objection, which appears to have been made on the basis of mixed statutory subject matter.

Furthermore, Applicant has closely reviewed 37 CFR § 1.75 and finds no basis therein for the objection to claim 46 or amended claims 34, 35 and 47 on the basis of mixed statutory subject matter.

Yet further, Applicant has closely reviewed the provisions of 35 USC §112 and finds no basis for objection therein of claim 46 or amended claims 34, 35, and 47 on the basis of mixed statutory subject matter.

On the contrary, MPEP Section 608.01(n) at page 600-63 under the subsection entitled "Infringement Test", does indicate that the type of claim as recited in claim 46, amended claims 34, 35, and 47, and added claims 48-71, is in fact a proper claim. Page 600-63 indicates in part:

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.

Furthermore, since claim 46, amended claim 34, and added claims 48-55, are not strictly product-by-process claims, any requirement that the product be uniquely obtainable from the claimed process should not apply.

In regard to amended claims 35 and 47 as well as added claims 56-71, which are dependent claims directed to an optical disk system including a previously claimed control apparatus, Applicant similarly believes that neither the Statute, the Regulations, nor the MPEP prohibits this style of dependent claim. Applicant further believes that the above-cited Section of the MPEP at page 600-63 supports this type of claim.

Thus in view of the above, since the multiple dependancies have been removed, and the fact that an independent claim and a dependent claim are in different statutory classes does not necessarily render the dependent claim

improper, Applicant believes that claim 46, and amended claims 34, 35, and 47 are proper claims and thus should be allowed in accordance with the provisions of the Statute, the Regulations, and Section 608.01(n) of the MPEP. Similarly, added claims 48-71 are also believed to be allowable in view thereof.

III. Concluding Matters

In view of the foregoing amendments and remarks, it is respectfully submitted that this application, including allowed claims 1 and 17-47, as amended where indicated, and added claims 48-71, is in condition for issuance.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, he is herein kindly requested to call Applicant's attorney at the phone number noted below.

Respectfully submitted,

DISCOVISION ASSOCIATES

Donald Bollella
Reg. No. 35,451

Date: April 7, 1999

DISCOVISION ASSOCIATES
P.O. Box 19616
Irvine, California 92614
(949) 660-5000

P:\PATPROSE\MMI951028--(US)USC1X1X1D1X1X1D1.AM1

FILING OF CORRESPONDENCE BY EXPRESS MAIL
UNDER 37 C.F.R. § 1.10

EM371812306US

April 7, 1999

Express Mail Label Number Date of Deposit

D